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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,502	11/15/2003	Clair John Glossner III	YOR919990548US4 (8728-341)	9966
46069	7590	07/12/2005	EXAMINER	
F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			PAN, DANIEL H	
			ART UNIT	PAPER NUMBER
			2183	

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,502

Applicant(s)

GLOSSNER ET AL.

Examiner

Daniel Pan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-11, 14-22, 25-33, 48, 50, 51 and 54-56 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2, 12, 13, 23, 24, 34-47, 49, 52, 53 and 57-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) see paragraph 3-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claims 1-2, 12-13, 23,24 , 34-47, 49, 52,53 , 57-60 have been canceled. Claims 3-11,14-22,25-33,48,50,51,54-56 remain for examination.

2. The following action includes new ground of rejection based on the recent "101" guideline from the Tech Center which was not available at the time of the examination. Therefore, in order to allow applicant a chance to respond, this is a non-final action. Discussions in response to applicant's remarks and arguments will be addressed as well in this action. The Terminal Disclaimer filed on 04/25/05 has been received and considered.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 3,4,5, 9,10, 11, 14, 20, 21,22, 25, 26, 27, 31, 32, 33, 48,54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The reasons are given below.

4. As to claims 3,4,5, 9,10, 11, none of the claimed elements is necessarily implemented in hardware. For example, the storage of the data elements and the identification of the pointer array entries could be implemented in program per se. Therefore, it is not tangible. Furthermore, the storage of the data elements are directed to non-functional descriptive material. When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not

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make it statutory. Such a result would exalt form over substance. In *re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in *Abele*, 684 F.2d at 907, 214 USPQ at 687). See also *In re Johnson*, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

5. As to claims 14, 20, 21,22, None of the steps is necessarily implemented in hardware (see discussions set forth above). Furthermore, The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to from the basis of statutory subject matter under 35 U.S.C. 101.

6. As to claims 25, 26, 27, 31, 32, 33, Claims 25, 26, 27, 31, 32, 33 are not limited to tangible embodiments. In view of Applicant's disclosure, specification page 6, line [20-22], page 14, lines 20-22, page 26, line 22, page 27, line 1, page 25, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., [program readable storage device readable by machine]) and

intangible embodiments (e.g., [program or software])). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

7. As to claims 48, 54, none of the claimed elements is necessarily implemented in hardware. For example, the vector memory area could be represented by variable in program per se. The controller could also be presented by a programming routine per se. The address pointer information stored in the pointer memory area is directed to the non-functional descriptive material (see discussion above). Therefore, not tangible.

8. Claims 48, 50, 51, 54, 55, 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karp et al. (5,689,653) in view of Pawate et al. (5,528,550).

9. As to newly amended claim 48, Pawate also disclosed the address held in each row or column of the pointer array correspond to a different vector element (see each vector V pointing to a next element V_{n-1} in fig.4, lines 65-67, col.6, lines 1-3).

10. As to the amended claim 54, the amended feature of each element stored in the vector memory area and the identified element does not change the original scope of the claim. Because the original claim already recited the pointer memory array area containing address information identifying the portions of the vector to access.

11. The rejections are maintained and incorporated by reference the last Office action on 01/21/05.

12. The response filed by applicant on 04/25/05 have been fully considered but is not persuasive.

13. In the remarks, applicant argued that :

a) each pointer of Pawate point to an entire vector, and does not teach a pointer for each element of the vector.

14. As to a) above, Pawate disclosed a linked -list of vectors and each pointer pointed to a vector (see col.5, lines 63-66, fig.4). Since no structural relationship of the vector elements has been reflected into the claim, the vector elements are read as the vectors. Pawate did disclose the pointer pointed to element of the vector (see the pointers pointing to the vectors in fig.4).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Pan whose telephone number is 703 305 9696, or the new number 571 272 4172. The examiner can normally be reached on M-F from 8:30 AM to 4:00 PM.

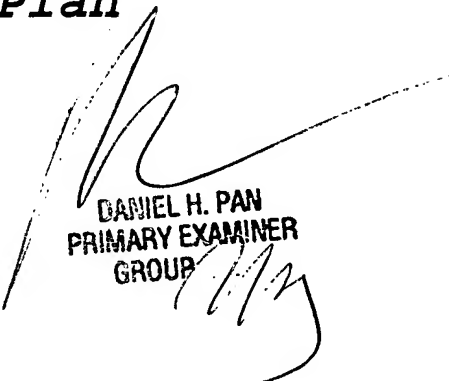
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chan, can be reached on 703 305 9712, or the new number 571 272 4162. The fax phone number for the organization where this application or proceeding is assigned is 703 306 5404.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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21 Century Strategic Plan



DANIEL H. PAN
PRIMARY EXAMINER
GROUP